

Notice of Allowability

Application No.

10/692,738

Examiner

Jason H. Johnsen

Applicant(s)

OSHUMI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to 10/27/03.
2. ☐ The allowed claim(s) is/are 1-20.
3. ☐ The drawings filed on N/A are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

REASON'S FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: The primary reason for the allowance of the claims is the inclusion of the limitation for the Z substituent in independent claims 1 and 10 which is not found in the prior art references. In claim 1 of the instant application, Z is defined as a cyclic alkyl group which may have a substituent(s), a cyclic unsaturated alkyl group which may have a substituent(s), a lower alkyl group having a cyclic alkyl group which may have a substituent(s), or a lower alkyl group having a cyclic unsaturated alkyl group which may have a substituent(s). Some representative examples given in the specification for such compounds are cyclopropyl, cyclobutyl and cyclopentyl groups. This is found to be unobvious over the nearest prior art reference, Patent No. 6,815,428, which teaches the same core structure but with a diverging Z substituent--it being defined as an aralkyl group or a phenyl group, among other things.

Additionally, claim 10 of the instant application defines the Z substituent to be a halo lower alkyl group. This too is found unobvious over the nearest prior art reference, Patent No. 6,815,428, which teaches the same core structure but with a diverging Z substituent—a perfluoro lower alkyl group. This is the case inasmuch as the specification of the instant application and the disclosure of Patent No. 6,815,428 define a perfluoro group to mean all of the hydrogens bonded to the carbons of the substituent are substituted with fluorine, compared to a halo lower alkyl group of instant application, which could broadly be read to mean all hydrogens bonded to the carbons of the lower alkyl group but one are substituted with any halogen, including fluorine. Examples of fluoro lower alkyl groups include monofluoromethyl, difluoromethyl, and 2,2-

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difluoroethyl. Examples of perfluoro lower alkyl groups include trifluoromethyl, pentafluoroethyl, and heptafluoropropyl.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

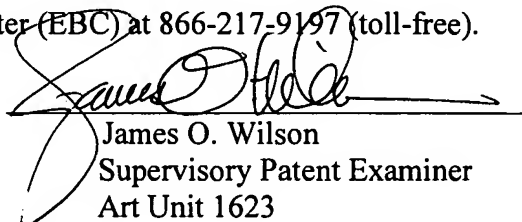
Conclusion

For questions contact **Jason H. Johnsen** whose telephone number is **571-272-3106**. The examiner can normally be reached on Mon-Friday, 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason H. Johnsen
Patent Examiner
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James O. Wilson
Supervisory Patent Examiner
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